

**REMARKS**

**I. Status of Claims**

Claims 92-230, 235-242, 245-248, 250, 251, 253, 256-259, 262, 263, 266, 267, 269, 273-275, 279-287 are pending. Claims 1-92, 231-234, 243, 244, 249, 252, 254, 255, 260, 261, 264, 265, 268, 270-272, and 276-278 have been withdrawn. No claims have been amended by this Response.

In their January 16, 2003, Amendment and further to the discussion at the January 14, 2003, Interview, Applicants respectfully requested that claims 1-91, 231-234, 243, 244, 249, 252, 254, 255, 260, 261, 264, and 265, which were initially restricted out of the application, be rejoined. Applicants note that claims 268, 270-272, and 276-278 were also initially restricted out of the Application, and request herein that all of the claims making up the restricted Group I be rejoined in the instant application. While the Examiner did not indicate that Group I has been rejoined, the instant Office Action rejects withdrawn claim 1. Therefore, in view of the examination of claim 1, Applicants respectfully request that the withdrawn claims be rejoined so that all of claims 1-287 are pending. Alternatively, Applicants request that the Examiner clarify the status of the restriction requirement and clearly set forth the withdrawn claims, especially as regards rejected claim 1.

**II. Amendment to the Specification**

The percentage of Parleam oil present in the composition of Example 1 has been amended to correct an inadvertent typographical error. The error would have been apparent to one of ordinary skill in the art reading Example 1, as one of ordinary skill would readily recognize that the total percentage by mass of the composition must add up to 100.00%.

Likewise, not only would one of ordinary skill in the art have recognized the error, one of ordinary skill would also recognize the appropriate correction for this error. Specifically, when formulating a lipstick composition, one of ordinary skill would recognize that Parleam oil would be used in a much greater percentage by mass in order to formulate a lipstick with a consistency typical for the art of lipstick compositions.

Accordingly, the amendment to Example 1 falls squarely within the requirements of M.P.E.P. §2163.07, which states that an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the errors in the specification, but would also recognize the appropriate correction. See In re Oda, 443 F.2d 1200, 170 U.S.P.Q. 260 (C.C.P.A. 1971).

### **III. Rejection under 35 U.S.C. § 112**

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. The Examiner first notes that page 26 of the instant specification recites that “representative pasty fatty substances which may be used in the composition according to the invention include lanolins and lanolin derivatives . . . .” Office Action at 2. The Examiner then notes that claim 1 recites “at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature.” *Id.* From this, the Examiner requests clarification as to “[w]hich pasty fatty substances recited above meet this requirement[.]” *Id.* This rejection is respectfully traversed.

Applicants respond that lanolins and lanolin derivatives are indeed one of many non-limiting examples of at least one pasty fatty substance comprising at least one liquid fraction and at least one solid fraction at room temperature.

Regarding definiteness, the Examiner has not established that one skilled in the art would not understand the phrase "at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature," as claimed herein. Furthermore, the test for definiteness has been satisfied in that "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. § 2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). As filed, the instant specification defines a pasty fatty substance in part as "a viscous product comprising a liquid fraction and a solid fraction," as part of a detailed discussion of pasty fatty substances on pages 25-27 of the specification. Thus one skilled in the art would understand the phrase and as confirmed herein would understand that lanolin and lanolin derivatives are non-limiting examples thereof. Therefore, Applicants respectfully request reconsideration of the rejection.

Applicants additionally note for the record that claims 92, 185, 218-230, and 282, in addition to withdrawn claim 1, all contain the language "at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature." Therefore, the foregoing discussion applies with equal force to all of claims 1, 92, 185, 218-230, and 282, although only claim 1 has been rejected.

#### **IV. Rejection under 35 U.S.C. § 103**

Claims 92-230, 235-242, 245-248, 250, 251, 253, 256-259, 262, 263, 269, 273-275, and 279-287 have been rejected under 35 U.S.C. § 103 as obvious over U.S.

Patent No. 5,783,657 to Pavlin et al. ("Pavlin '657") and U.S. Patent No. 3,148,125 to Strianse et al. ("Strianse").

According to the Examiner, Pavlin '657 discloses the elements of the rejected claims, with the exception that "Pavlin does not teach ingredient (ii), which recites 'at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature' . . . ." Office Action at 4. The Examiner attempts to rectify this deficiency by relying on Strianse as teaching "a clear lipstick comprising lanolin alcohols . . . and fatty acid esters such as oleates, mono laureates and linoleates." *Id.*

The Examiner then states that such a combination would have been within the ordinary skill in the art, as one would allegedly "have been motivated to modify the composition of Pavlin to include a pasty fatty substance, because Pavlin teaches an anhydrous composition comprising a transparent gel composition which comprises a structuring polymer consisting of an ester-terminated polyamide resin combined with a liquid hydrocarbon." *Id.* Applicants respectfully traverse this rejection on the grounds that the Examiner has failed to establish a *prima facie* case of obviousness.

In order to establish such a case, the Examiner must demonstrate, among other things, some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the reference or combine reference teachings. M.P.E.P. § 2143. In the instant case, there is no such suggestion or motivation.

While Strianse does admittedly disclose, in a laundry list of optional ingredients, fatty acid esters and lanolin alcohols, not all fatty acid esters, including several of the

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compounds listed in Strianse, are pasty fatty substances as defined by the instant claims. The Examiner herself recognizes that not all fatty acid esters are pasty fatty substances, as she explicitly notes that Pavlin '657 teaches fatty acid esters (see Office Action at 3), but does not teach "at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature." *Id.* at 4.

Even assuming *arguendo* one of the numerous compounds listed in Strianse (see, e.g., col. 2, l. 70 to col. 3, l. 4; col. 3, ll. 48-53) is a pasty fatty substance, the compounds disclosed in Strianse are not generally classified as pasty fatty substances. Without motivation, which here is only provided by the instant specification in hindsight, one of ordinary skill would not look to select a compound from the list of Strianse based on the characteristic of being fatty pasty. The Examiner has not established any independent motivation for one of ordinary skill in the art to pick and choose one specific pasty fatty substance out of a broad general list encompassing all fatty acid esters and fatty alcohols, let alone motivation to combine that pasty fatty substance with the composition of Pavlin.

Here, contrary to the position taken by the Examiner, the prior art references, when considered in their entirety, provide no motivation to make the suggested combination. The necessary picking and choosing of a single compound is not permissible in establishing a *prima facie* case of obviousness: "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In*

re *Wesslau*, 353 F.2d 238, 241 (C.C.P.A. 1965). As there is no motivation in either reference to combine at least one pasty fatty substance, wherein said at least one pasty fatty substance comprises at least one liquid fraction and at least one solid fraction at room temperature, with the composition of Pavlin, no *prima facie* case of obviousness has been established. Accordingly, Applicants respectfully request withdrawal of the rejection on this ground.

#### IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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